

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RUSSEL SHIRLEY,  
MICHAEL R. CONBOY and  
HORACE PAUL BOWSER, JR.



Appeal No. 2005-1461  
Application 10/010,412

ON BRIEF

Before THOMAS, BARRETT and SAADAT, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1-6 and 8-15.

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Representative claim 1 is reproduced below:

1. A computer-based automated method for tracking the movement of masks used in a wafer processing facility, the masks being moved in masks pods, the method comprising:

for each mask, generating mask data that includes a mask identification code; and

using a computer to process the mask data, including cross-referencing respective mask identification codes to pod identification codes, and updated the mask data to include a facility location identification code.

The following references are relied on by the examiner:

Terao 5,191,535 Mar. 2, 1993

Wiesler et al. (Wiesler) US2001/0047222 Nov, 29, 2001  
(effective filing date Apr. 25, 2000)

Claims 1-6 and 9-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wiesler. Claims 8 and 15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Wiesler in view of Terao.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief for the appellants' positions (no reply brief

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has been filed) and to the answer for the respective details thereof. In response to the earlier panel's Remand to the Examiner dated November 24, 2004, the examiner has provided a responsive communication on April 20, 2005, addressing the reasons for the remand. Appellants have not responded by the filing of any supplemental brief in response to this additional communication from the examiner.

OPINION

The final rejection correlates the subject matter of the Wiesler Patent Publication to the subject matter of claims 1-6 and 9-14 rejected under 35 U.S.C. § 102. In response to our Remand, the examiner has correlated each of these respective claims, the Wiesler patent application publication, as was done in the final rejection, additionally adding correlations for each feature of each of these claims to the underlying provisional application filing document.

Based on this correlation, which appears to be in compliance with the nature of the remand from a previous panel, we have concluded that the

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examiner has established a prima facie case of anticipation of certain claims on appeal and, respectively, of those claims rejected under 35 U.S.C. § 103. In reaching this determination we have also reviewed the document entitled "PRI Automation, Reticle Management System" underlying the original provisional application to Wiesler's patent application publication.

As to the merits of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103, as set forth as Issues 2 and 3 beginning at page 6 of the brief on appeal, we are satisfied that the examiner has established a prima facie case in each instance based on the expanded rationale noted earlier in the responsive communication to our remand from the examiner dated April 20, 2005, in addition to the responsive arguments set forth by the examiner as to these rejections at pages 10-12 of the answer. There, the examiner specifically addresses each of the concerns raised by appellants in the noted pages of the brief.

Of particular note, we find essentially without merit appellants' urging that the record reflects that the examiner's position with respect to

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the rejection under 35 U.S.C. § 103 is devoid of any motivation analyses to combine the Wiesler patent application publication with Terao. It appears to us in studying appellants' remarks beginning at the bottom of page 7 of the brief that appellants just disagree with the examiner's rationale. The urging that the combination cannot undermine the purpose of the primary reference is undeveloped and appears to be mere conjecture. The teaching value of Terao is noted by the examiner initially in the context that both references are from the same field of invention and therefore are analogous art, which has not been challenged by appellants. The artisan would well consider the ability and additional teachings of the Terao system to have enhanced the Wiesler publication since even Figure 3 of Terao clearly shows the ability to match a reticle by serial number and a wafer lot to a given event of a processing line as Figure 3 depicts. This correlation obviously extends the correlation of the database structures outlined and detailed in Wiesler's patent application publication.

Lastly, we turn to appellants' initial concern in Issue 1 at pages 5-7 of the brief, where appellants have essentially requested evidence that the

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written description of the provisional application adequately corresponds to the teachings of the corresponding patent application publication to Wiesler relied upon by the examiner to reject the claims on appeal. As the record reflects, the actual filing date of the patent application publication of April 25, 2001, does not provide a sufficient priority date to meet the effective priority date of the present application of September 19, 2000. The examiner therefore relies upon the provisional application filing date of April 25, 2000, as the basis of the art rejections of the claims on appeal.

Given that appellants have set forth reasonable basis to require the examiner to provide copies of the original PRI automation document in the provisional application, and in view of the fact that the file history reveals that the examiner has not done so, we provide a copy of it attached to this opinion. It is noted that MPEP § 2136.03 topic III indicates that the priority of a provisional application under 35 U.S.C. § 102(e) is the filing date of the provisional application as long as the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph.

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We observe here that the provisional application document to the PRI automation publication appears to be based upon an artisan's understanding of the art in question such as that expressed in the background of the specification as filed at specification page 1, line 14 through specification page 3, line 21. In an effort to not further delay the prosecution in this application by additional remands, we find adequate basis for the examiner to have established rejections under 35 U.S.C. §§ 102 and 103 as noted earlier noted in this opinion. Likewise, in an effort to further expedite the handling of this appeal before us, we provide copies of the PRI Information document as an attachment to this opinion. As such, and in view of appellants' arguments in Issue 1 beginning at page 5 of the brief on appeal, and in a sense of fundamental fairness to applicants, we will designate this affirmation as a new ground of rejection within the provisions of 37 CFR 41.50(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR

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§ 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

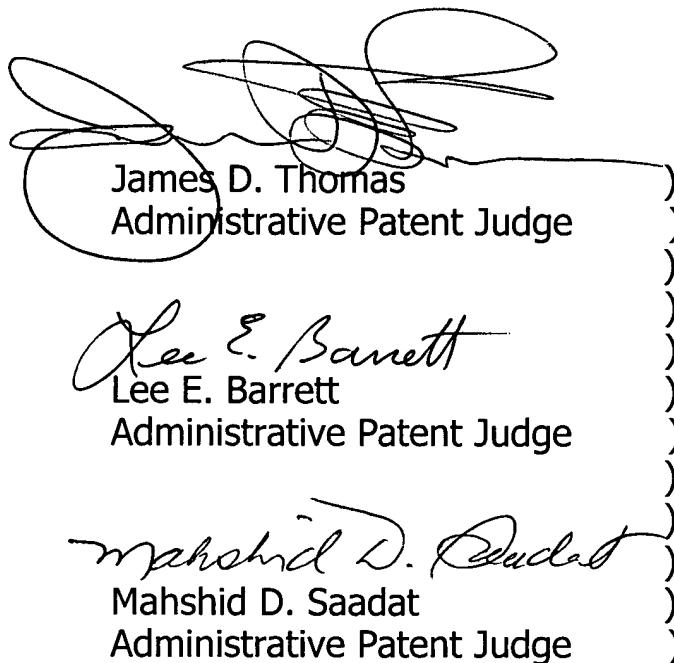
(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED; 37 CFR § 41.50(b)

  
James D. Thomas )  
Administrative Patent Judge )  
Lee E. Barrett ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
Mahshid D. Saadat ) INTERFERENCES  
Administrative Patent Judge )

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Robert J. Crawford  
CRAWFORD MAUNU, PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120